

Response Under 37 CFR 1.116

Expedited Procedure

Examining Group 1700

Application No. 10/662,077

Paper Dated August 17, 2006

In Reply to USPTO Office Action dated May 18, 2006

Attorney Docket No. 1887A1/RC

pigments, which is selected so that the pigment particles will not scatter light effectively. No new matter is added by this amendment; this language is found in the specification at pages 5-6, paragraph [0025]. Claims 3, 14, 20, 30 and 38 are amended to correct a spelling error. Applicants respectfully request entry of the above amendments to permit the present application to proceed to allowance.

35 U.S.C. §112 Rejections

Claims 1-4, 6-21, 23-29 and 41-44 were rejected under 35 U.S.C. §112, first paragraph, as allegedly being not enabled. Applicants respectfully traverse this rejection as it may pertain to the amended claims.

It is asserted in the Office Action that the rejected claims do not reasonably provide enablement for use of particle sizes above 150 nm. Applicants respectfully disagree with this assertion.

As amended, Claims 1, 18 and 34 are directed to compositions in which the size of the colorant pigment particle (when the colorant comprises colorant pigments) is selected so that the pigment particle does not scatter light effectively. One skilled in the art can easily determine if a particular pigment size meets this requirement; there is more than adequate guidance in the specification for determination of which particle sizes above 150 nm will work. As pointed out in the Office Action and explained in the specification at paragraph [0025], if the pigment particle size is too large it will mask the fluorescence of the coating and induce significant diffuse reflectance which would be observed over a wide range of viewing angles. This language provides objective criteria by which a composition having a pigment particle size over 150 nm can be judged as suitable and within the bounds of the present claims.

A firm limit to particle size is not supported by the teachings of the specification as a whole. The language describing desirable particle sizes for colorant pigments reads, “A

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suitable primary particle size...is less than about 150 nm . . ." (specification at page 7, paragraph [0026], emphasis added). This language is not limiting, and indicates a preference, not a requirement. At no point in the application is there any indication that particle sizes above 150 will not work, or that the upper limit is critical. All other discussion of particle size in the application is in general terms, indicating Applicants' intent not to be bound by the particle size described above. For example, in paragraph [0026], page 7, preparation of the particles is described: "The pigment particles are milled to nanoparticulate sizes"

The MPEP would appear to support Applicants' position. According to the MPEP at 2164.08(c),

In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976). An enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

Thus, it is respectfully submitted that the Office Action fails to set forth a *prima facie* case of lack of enablement. As explained by the CCPA in *In re Marzocchi and Richard C. Horton*, 439 F.2d 220 (1971), the recitation of a generic term must be taken as an assertion that all compounds falling within the generic term are operative, and the Patent Office must explain why it doubts the truth or accuracy of any statement in the disclosure and back up its assertions with acceptable evidence or reasoning. *Id. at 1072-1073*. Applying this case to the facts at hand, the generic term being "the particle size of the colorant pigment being selected so that the pigment particles will not scatter light effectively", the Office Action fails to set forth adequate reasons for asserting that any particular particle sizes falling within this category above 150 nm will not work, or that one skilled in the art would be unable to

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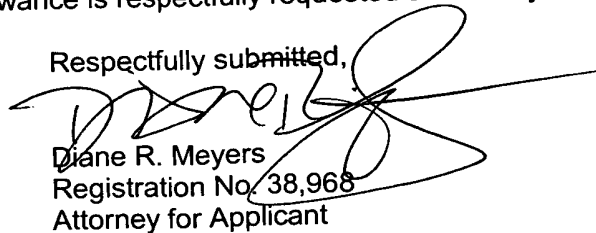
determine a suitable particle size without undue experimentation, based on the guidance provided in the application.

The Office Action also appears to take issue with Applicants' use of the word "when", in the phrase "wherein when the colorant comprises colorant pigments". As explained throughout the specification and recited in Claim 2, a colorant according to the invention can comprise a dye and/or a pigment. If the colorant comprises only a dye, the colorant pigment size would be irrelevant. Because "when" qualifies the situation of "when" the colorant comprises colorant pigments, Applicants respectfully submit that use of the language "when the colorant comprises colorant pigments" is proper. Any rejection of these claims based on the use of this language should be withdrawn.

Claims 1-44 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. It is asserted that the claim language "colorant pigments do not induce significant diffuse reflectance" lacks support in the specification. While Applicants do not concede there is a lack of support, this language has been removed and replaced with the exact text found in the specification at page 6-7, paragraph [0025]: "the size of the pigments is selected so that the pigment particles will not scatter light effectively". Accordingly, Claims 1-44 meet the written description requirement under §112 of the statute.

In conclusion, Applicants respectfully submit that all pending claims, Claims 1-44, are fully enabled, in compliance with the written description requirement, and in condition for allowance. A Notice of Allowance is respectfully requested at an early date.

Respectfully submitted,



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